



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,841	11/21/2000	Arvin D. Danielson	36767YBB	6790

7590

08/08/2005

Michael F. Williams
Simmons Perrine Albright & Ellwood PLC
115 Third Street SE
Suite 1200
Cedar Rapids, IA 52401

EXAMINER

KIM, AHSHIK

ART UNIT PAPER NUMBER

2876

DATE MAILED: 08/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/717,841	Applicant(s) DANIELSON ET AL.	
	Examiner Ahshik Kim	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/16/05 (Response).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-29 and 37-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-29, 37-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Response Amendment***

1. Receipt is acknowledged of the amendment filed on May 16, 2005. No claims were
5 canceled, amended, or newly added. Currently, claims 16-29 and 37-44 remain for examination.

Obviousness-Type Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise
10 extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

- 15 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

- 20 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 16-29 and 37-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-72 of US Patent 6,149,062 to Danielson et al. (hereinafter '062 patent).

- 25 Although the conflicting claims are not identical, it is the Examiner's view that they are not patentably distinct from each other. In claim 16 of the instant application, the Applicant claims "A data processing system, comprising: (a) a data processing assembly including an interface unit; and (b) a detachable reader unit detachably assembled with said interface unit; (c) said detachable reader unit comprising a non-contact data reader to read data disposed in non-

Art Unit: 2876

contact relationship to said reader unit; wherein said data processing assembly is portable and

wherein said detachable reader unit dose not extend said data processing assembly's width or

length when attached thereto." Claim 1 of '062 patent recites "A hand-held data collection

system, comprising: (a) a base unit, of size to be held in one hand during data collection, said

5 base unit comprising a user interface; and b) a detachable reader unit, capable of being coupled

with said base unit, said reader unit comprising a non-contact data reader reading data disposed

in non-contacting relationship to said reader unit, said reader unit further comprising an energy

source." In claim 72 of '062 patent, it is recited "A hand-held data collection system, a

detachable reader unit, capable of being coupled with said base unit, said base unit being

10 contained within said detachable reader unit's confines when coupled therewith, said reader unit

comprising a non-contact data reader reading data disposed in non-contacting relationship to said

reader unit, said reader unit further comprising an energy source." It appears that when they are

coupled, they do not extend each other's dimension.

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to

15 overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this

application. See 37 CFR 1.130(b).

Claim Rejections - 35 USC § 102

20 4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2876

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5 Claims 16-29 and 37-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Gombrich (US 4,916,441, hereinafter "Gombrich").

10 Re claims 16, 20, 21, 23, 27, 28, and 37-40, Gombrich discloses a portable hand-held data processing assembly (see figure 6; col. 1, lines 47+) comprising a barcode reader 22 and a base unit 31 (col. 4, lines 38+; col. 5, lines 51+). When the reader is inserted into a base unit, they appear to be one unit – one does not extend the other's dimension (see figure 6).

 Re claims 17-19, 24-26, 43, and 44, the reader 22 can read a barcode, and further
15 equipped with keyboard so that users can manually enter data (col. 2, lines 3+)

 Re claims 22, 29, and 41 , as shown in figure 5, the terminal can communicate with external devices (or host) via wireless communication (col. 5, lines 34+).

 Re claim 42, as shown in figure 16, the battery 80 provides operating power to the data collection module (col. 8, lines 62+).

20
Response to Arguments

6. Applicant's remarks filed on May 16, 2005 have been carefully reviewed and considered.

 It is the Examiner's view that Examiner has established a prima facie case of non-statutory-type obviousness double patenting rejection. Examiner believes that at least three
25 factors Applicant mentioned in the remarks have been fully met. First, claims under consideration are 16-29 and 37-44 and patented claims are 1-72 of '062 patent. In paragraph 3 above, claim 16 was further detailed in comparison with claim 72 of '062 patent. Second, with

Art Unit: 2876

respect to variation, it is the Examiner's view that claim 16 of the instant application and claim 72 of '062 patent are virtually identical, at least identical to one ordinary skill in the art of optical scanners or portable data-reading apparatus. Third, analysis was detailed in paragraph 3 above.

Perhaps, the Examiner wasn't clear whether claim 16 of the instant application was
5 rejected on bases of combining claims 1 and 72 of '062 patent or solely based on claim 72. It is the Examiner's position that claim 72 by itself would be sufficient to reject claim 16. At least in the Examiner's skill level, there's no distinction between claim 16 of the instant application and claim 72 of '062 patent. Applicant's explanations that "..... as a "base unit is contained with the "detachable reader unit's" confines. By way of contrast, pending claim 16 specifies that the
10 detachable portion containing the reader unit does not extend the width or length of the "data processing assembly.", at least in the Examiner's reading, do not distinguish two claims, at least to the extent they are patentably distinct.

Examiner appreciates Applicant providing the record for 07/143,921 application. The definition of CIP, according to MPEP states "adding matter not disclosed in the said
15 nonprovisional application (In re Klein, 1930 C.D. 2, 393 O.G. 519 (Comm'r Pat. 1930))." (See MPEP 201.08.). Reviewing the figures 9 and 10, the subject matter claimed in the instant application is already disclosed at least in drawings. Accordingly, Examiner requests the Applicant to explicitly state, for making the record clear, what subject matter not disclosed in 07/143,921 is claimed in the instant applicant. Until such record becomes clear, it is the
20 Examiner's view that Examiner can only acknowledge the filing date of US 5,227,614, which is December 15,1989.

It is the Examiner's view that previous Office Action responded to the merits of the claimed invention. Applicant's response was carefully reviewed, but they are not persuasive. Therefore, the Examiner has made this Office Action final.

5 *Conclusion*

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ahshik Kim whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday. The fax number directly to the Examiner is (571)273-2393.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax phone number for this Group is (703)872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly

Art Unit: 2876

signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

5 Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Ahshik Kim
Primary Examiner
Art Unit 2876
August 3, 2005